

REMARKS

Applicant has carefully reviewed the Office Action of October 8, 2003 and offers the following remarks to accompany the above amendments.

Applicant initially amends claim 8 to correct a typographical error. No new matter is added.

Claims 1, 18, and 24 were rejected under 35 U.S.C. § 112 as being indefinite because the term "skeleton definition language" is not clearly defined. Applicant respectfully traverses. While Applicant acknowledges that limitations in the specification are not imported into the claims, whether a claim element is defined enough to be definite may be determined by reference to the specification. In this particular case, the term "skeleton definition language" is discussed at page 19, lines 17-22 with sufficient particularity to make the claim term definite for the purposes of a § 112 analysis. In light of this explanation, Applicant requests withdrawal of the § 112 rejection at this time.

Claims 1-5 and 18-25 were rejected under 35 U.S.C. § 103 as being unpatentable over Logan et al. in view of Caughran et al. and further in view of Ushiku. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located. MPEP § 2143.03. Furthermore, the Patent Office is obligated to provide objective evidence as to where the motivation to combine the references may be found. If the Patent Office cannot show a claim element or cannot show the requisite objective evidence, then Applicant is entitled to a patent.

As amended, the independent claims 1, 18, and 24 recite that the skeleton definition language functions as a directive for control of the transformation. Support for this can be found at page 19, lines 21-22 of the specification. The Patent Office admits that Logan et al. and Caughran et al. do not teach or suggest the originally recited skeleton language and relies on Ushiku for the skeleton language. Applicant herein clarifies the nature of the skeleton language. In contrast, the skeleton language of Ushiku is used to describe the published page and for publishing electronic mail, not to control the transformation. To this extent, the references individually do not show a claim element, and no objective evidence showing the motivation to combine the references is provided. Since the references individually do not show a claim element, the combination of references cannot teach or suggest the claim element, and the Patent Office has not established *prima facie* obviousness. Further, there is no expectation that

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combining the teachings of the references would result in an operational system, let alone the claimed invention.

Claims 6-9, 15, and 16 were rejected under 35 U.S.C. § 103 as being unpatentable over Logan et al. in view of Kirsch. The standard for obviousness is set forth above. Applicant respectfully traverses. Claims 6-9, 15, and 16 depend from claim 1, and include the elements of the underlying independent claim. In the analysis of claim 1, the Patent Office admits that Logan et al. does not show all the claim elements for claim 1 and relies on Ushiku and Caughran et al. for support. Since claim 6 has the elements of claim 1, Logan et al. without Ushiku and Caughran et al. cannot teach or suggest all the elements of claim 6. To this extent, the rejection of these claims is improper. However, Applicant proceeds as if Caughran et al. and Ushiku had been cited as part of the rejection. Nothing in Kirsch cures the deficiencies of the underlying combination of Logan et al., Caughran et al. and Ushiku. Since the references individually do not teach or suggest the specifics of the skeleton definition language, the combination of references cannot teach or suggest the claim element, and the claims are patentable.

Claims 10-14 were rejected under 35 U.S.C. § 103 as being unpatentable over Logan et al. in view of Loukianov and further in view of Kirsch. Applicant respectfully traverses. As explained above, this rejection is improper because it omits two references - namely, Caughran et al. and Ushiku. However, Applicant proceeds as if Caughran et al. and Ushiku had been cited as part of the rejection. Nothing in Loukianov cures the deficiencies of the underlying combination of Logan et al., Caughran et al., Ushiku, and Kirsch. Since the references individually do not teach or suggest the specifics of the skeleton definition language, the combination of references cannot teach or suggest the claim element, and the claims are patentable.

Claim 17 was rejected under 35 U.S.C. § 103 as being unpatentable over Logan et al. in view of Caughran et al. and further in view of Ushiku and further in view of Ahanessians et al. Applicant respectfully traverses. Nothing in Ahanessians et al. cures the deficiencies of the underlying combination of Logan et al., Caughran et al., and Ushiku. Since the references individually do not teach or suggest the specifics of the skeleton definition language, the combination of references cannot teach or suggest the claim element, and the claims are patentable. Further, with this and the previous rejections, there is simply no motivation to combine the references and any resultant combination would not lead to a workable solution, let alone the claimed invention.

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Applicant requests entry of the amendment and consideration of the arguments presented herein. In light of the deficiencies of the references, Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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